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09/475,165	12/30/1999	FEN-CHUNG KUNG	1999-0300	6026

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EXAMINER

WILSON, ROBERT W

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/475,165

Applicant(s)

KUNG ET AL.

Examiner

Robert W Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1.0 The application of Chung Kung et al. for a "BRG WITH PBX CAPABILITIES" which was filed on December 30, 1999 without foreign priority. The case was examined and Claims 1-24 are pending.

Drawings

2.0 The drawings were accepted by the draftsman.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.0 Claims 1-6 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U.S. Patent No.: 6,141,341)

Referring to Claim 1, Jones teaches: residential gateway (10 per Fig 2) communication network (12 or 16 per Fig 2);

residential PBX (10 per Fig 20) Central processing unit (System Controller per col 3 lines 13-34), memory (memory per col 3 lines 13-34), at least one phone interface (22 per Fig 3) and;

an Internet Protocol Central Station connected to the residential PBX system providing access to at least one telephone (14 per Fig 2) to the communication network (12 or 16 per Fig 2);

In Addition:

Wireless connection (28 per Fig 2) as claimed in **Claim 2**.

Fiber optic cable (20 per Fig 3 or cable. Fiber optic cable is well known in the art. Fiber optic cable is a design choice) as claimed in **Claim 3**.

Hybrid fiber (20 per Fig 3 or cable. Hybrid Fiber optic cable is well known in the art. Hybrid Fiber optic cable is a design choice) as claimed in **Claim 4**.

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Cable (20 per Fig 3 or cable) as claimed in **Claim 5**.

IP telephone (POTs converted to IP or IP telephone by 10 per Fig 2) as claimed in **Claim 6**.

Analog telephone (POTS 26 per Fig 2 or analog telephone) as claimed in **Claim 8**

Analog connected via A/D (Codec converts from A/D per col 3 lines 41-46) as claimed in **Claim 9**.

Computer (Ethernet interface as well as H.323 Engine per Fig 4 and supports E-Mail per col 6 lines 34-65. It would be obvious to one of ordinary skill in the art at the time of the invention that these functions and interfaces are for a computer) as claimed in **Claim 10**

Ethernet interface (Ethernet interface per Fig 4) as claimed in **Claim 11**.

Second residential PBX (The examiner takes official notice that a second residential PBX is well known in the art as demonstrated by Chang (U.S. Patent No.: 6118,864). Change teaches the PBX is connected to the CP in Figures 1C and 1D respectively and according to Fig 1A a PBX is already a part of the CP) as claimed in **Claim 12**.

Connect the second PBX to the first PBX via IP (The examiner takes official notice that a second residential PBX is well known in the art as demonstrated by Chang (U.S. Patent No.: 6118,864). Change teaches the PBX is connected to the CP in Figures 1C and 1D respectively and according to Fig 1A a PBX is already a part of the CP. The PBXs are connected via 4 per Fig 1A which is TCP/IP) as Claimed in **Claim 13**.

Jones does not expressly call for: CP but teaches 14 per Fig 2.

It would be obvious to one of ordinary skill in the art at the time of the invention that 14 per Fig 2 performs the function of a router, DSL, etc which is obviously the same function as that is being performed by the CP.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.0 Claims 7 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U.S. Patent No.: 6,141,341) in view of Swartz (U.S. Patent No.: 6,330,244B1)

Referring to claim 7, Jones teaches: The residential gateway for accessing a communication network of claim 6,

Jones does not expressly call for: wherein the Internet protocol telephone is connected to the residential PBX by an Internet protocol telephone interface but teaches a connection to the PBX via wireless per 28 per Fig 2 and teaches a Digital over air phone per col 2 lines 64-65

Swartz teaches: wherein the Internet protocol telephone is connected to the residential PBX by an Internet protocol telephone interface (MUs are wireless IP phones which are connected to the PBX or 33 per Fig 1 via IP interfaces)

It would be obvious to add the IP telephones of Swartz to the network with Wireless connections to the PBX Jones because the IP telephones of Swartz are wireless.

Referring to Claim 15, Jones teaches: residential gateway (10 per Fig 2) communication network (12 or 16 per Fig 2);

residential PBX (10 per Fig 20) Central processing unit (System Controller per col 3 lines 13-34), memory (memory per col 3 lines 13-34), at least one phone interface (22 per Fig 3) and; buffer area (memory per col 3 lines 13-34) and CPU (System controller per col 3 lines 13-34)

In Addition:

Wherein the at least one telephone is capable of making a public switched telephone network communication connection to a second telephone (26 is a telephone that can make telephone calls through the PSTN network or element 16 to an inherent second telephone as shown in Fig 2) as claimed in **Claim 16**.

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Wherein the at least one telephone is capable of making a point to point connection on the communication network (26 is a telephone that can make telephone calls through the PSTN network or element 16 to an inherent second telephone or point to point connection as shown in Fig 2) as claimed in **Claim 17**.

Jones does not expressly call for: at least one Internet Protocol telephone connected to the residential PBX system via at least one Internet protocol telephone interface but teaches a Digital over air phone per col 2 lines 64-65 and at least one software application stored in the memory capable of implementing call features of the residential PBX but teaches a system controller per col 3 lines 13-34)

Swartz teaches: at least one Internet Protocol telephone connected to the residential PBX system via at least one Internet protocol telephone interface (MU or wireless phone which utilizes IP protocol per Fig 1) and

at least one software application stored in the memory capable of implementing call features of the residential PBX (voice message features per Abstract. It is within the level of one skilled in the art to implement the algorithms of Swartz into software)

In Addition:

Wherein the at least one telephone is capable of making a point-to-multi-point connection on the communication network (MU or telephone supports multiple conversations or point to multi point per col 14 lines 52-55) as claimed in **Claim 18**

It would be obvious to one of ordinary skill in the art at the time of the invention to add the IP phones of Swartz to the network of Jones because they are wireless phones which Jones utilizes within his invention.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

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international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.0 Claims 19-21 and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (U.S. Patent No.: 6,118,864)

Referring to Claim 19, Chang teaches: A method for providing calling services (Call holding, ... per Abstract) on a residential PBX (36 per Fig 1A), comprising the steps of

Determining if an incoming call to a called number has a POTS address, and if so, converting the POTS address to an Internet Protocol address (col 7 line 39-col 8 line 45 or Fig 5B);

Determining whether the caller desires to access residential PBX calling features and if so, implementing the residential PBX calling features, otherwise routing the incoming call to the Internet protocol address (col 7 line 40-col 8 line 45);

Determining if the called number has residential PBX calling features engaged, and if so, routing the incoming call according to the engaged residential PBX calling features (Deciphers' control signals per col 6 lines 51-65 and col 7 line 40-col 8 line 6)

In Addition:

Further comprising the step of determining whether the caller has authorization to access the residential PBX calling features (col 9 line 41-col 10 line 10 or Fig 2a) as claimed in **Claim 20**

Further comprising the step of rejecting the caller if the caller does not have authorization to access the residential PBX calling features (col 9 line 41-col 10 line 10 or Fig 2a or denied per col 9 line 41-col 10 line 1) as claimed in **Claim 21**.

Further comprising the step of allowing the rejected caller to enter another called number after attempting to gain authorization to the residential PBX calling features (Figs 2a-Fig 2B teach that alternative loops or paths. It would be obvious to one of ordinary skill in the art at the time of the invention to provide alternative logic upon being denied) as claimed per **Claim 22**.

Further comprising the step of receiving at the residential PBX a calling feature code corresponding to at least one calling feature to be implemented by the residential PBX (PBX generates control signals or feature codes for forwarding voice mail or initiating calling features per col 6 line 38-col 7 line 18) as claimed in **Claim 23**.

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Further comprising the step of allowing the caller to implement additional calling features after implementing a residential PBX calling feature (call features per Abstract and steps per Figs 2A-5B) as claimed in **Claim 24**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.0 Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (U.S. Patent No.: 6,118,864)

Referring to claim 15, Chang teaches: residential gateway (10 per Fig 2), network (4 per Fig 1A);

residential PBX (36 per Fig 1A), CPU (CPU per 1B), memory (memory per Fib 1B) at least one software application with call features (Comm Platform supports call features per col 7 line 64-col 8 line 8 or col 8 line 46-col 18 line 12. It is within the level of one skilled in the art to program the call features of Chang into software)

buffer memory (Memory per 1B and 20 provides the interface to 2 via 4 per Fig 1A);

Internet Central station (8,22,24, 28, and 38 or Internet Central station per Fig 1A)

In Addition:

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PSTN (6 per Fig 1A) as claimed in Claim 16.

Point to point (14A-14C per Fig 1A) as claimed in Claim 17

Point to multipoint (conferenceing-col 12 line 25-col 14 line 22) as claimed in Claim 18

Chang does not expressly call for: software implementation of call features but teaches call features per col 7 line 64-col 8 line 8 or col 8 line 46-col 18 line 12.

It is within the level of one skilled in the art to implement the call features of Chang into software. It would be obvious to one of ordinary skill in the art at the time of the invention to store the call feature program in the memory of Chang.

Claim Objections

7.0 Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The closest prior Chang (U.S. Patent No.: 6,118,864) teaches: denial upon entry of incorrect pin number; consequently, “step of allowing the rejected caller to enter another called number after attempting to gain authorization to the residential call features” would be allowable claim 22 was rewritten in independent form.

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Conclusion

8.0 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W Wilson whose telephone number is 703/305-4102. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Robert W Wilson
Examiner
Art Unit 2661

RWW
June 2, 2003



DANG TON
PRIMARY EXAMINER